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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,567	03/25/2004	Shoji Miura	01-583	4842
23400	7590	03/27/2006	EXAMINER LEWIS, MONICA	
POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			ART UNIT 2822	PAPER NUMBER

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/808,567

Applicant(s)

MIURA ET AL.

Examiner

Monica Lewis

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 and 15-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6 and 18 is/are rejected.
- 7) ☒ Claim(s) 4, 7, 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/04.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to the election filed December 29, 2005.

#### *Election/Restrictions*

2. Applicant's election of Embodiment I in the reply filed on 12/29/05 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

#### *Specification*

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5, 6 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Teshima et al. (U.S. Publication No. 2003/0132530).

In regards to claim 1, Teshima et al. ("Teshima") discloses the following:

a) an element of a semiconductor switching element (1) that includes two of a first and second surfaces, wherein a first electrode is exposed on the first surface, a second electrode is exposed on the second surface, and a control electrode is exposed on a control-electrode-exposing surface that is one of the first and second surfaces (For Example: See Figure 3 and Paragraph 33);

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b) two radiating members (5 and 6) between which the element is disposed, wherein the two radiating members are electrically connected with the first and second electrodes, respectively, wherein each of the two radiating members has an inward and outward surfaces, wherein the inward surface is closer to the element than the outward surface (For Example: See Figure 3);

c) a mold resin (9) member filling a space between the two radiating members (For Example: See Figure 3);

d) an insulating layer formed on at least one of the inward surfaces of the two radiating members (For Example: See Paragraph 48); and

e) a conductive layer (3) formed on the insulating layer and electrically connected with the control electrode and an input portion protruding from the mold resin member, wherein one of the first and second electrodes is electrically connected with a non-insulating portion of the inward surface where the insulating layer is formed, wherein no insulating layer is formed on the non-insulating portion (For Example: See Figure 3).

In regards to claim 2, Teshima discloses the following:

a) the control-electrode exposing surface of the element faces the conductive layer (For Example: See Figure 3).

In regards to claim 3, Teshima discloses the following:

a) the control electrode is, with the conductive layer, overlapped and electrically connected using a conductive connection member (4), and wherein one of the first and second electrodes that is exposed on the control-electrode-exposing surface is, with the non-insulating portion of the inward surface, overlapped and electrically connected using a conductive connection member (For Example: See Figure 3).

In regards to claim 5, Teshima discloses the following:

a) the conductive layer includes a pattern wiring formed of at least one of copper and copper alloy (For Example: See Paragraph 37).

In regards to claim 6, Teshima discloses the following:

a) insulating layer is formed of a heat resisting resin (For Example: See Paragraph 39).

In regards to claim 18, Teshima discloses the following:

a) input portion is included in the conductive layer (For Example: See Figure 3).

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***Allowable Subject Matter***

6. Claims 4, 7, 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica Lewis whose telephone number is 571-272-1838. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zandra Smith can be reached on 571-272-2429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular and after final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

ML

March 19, 2006

A handwritten signature in black ink, appearing to be 'CAG', located in the bottom right corner of the page.